



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/865,419	05/28/97	AUGER	S CLINK0002

JAMES C. WRAY  
1493 CHAIN BRIDGE ROAD  
SUITE 300  
MCLEAN VA 22101

IM51/1229

EXAMINER

LIOTT, C

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 12/29/98

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/865,419

Applicant(s)

Auger

Examiner

Caroline D. Liott

Group Art Unit

1751



☒ Responsive to communication(s) filed on Oct 19, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) 2-29 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 30-36 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's Amendments filed 10/19/98 have been entered. Applicant's Remarks filed 10/19/98 have been fully considered.

This application contains claims 2-29 drawn to an invention nonelected with traverse in Paper No. 11, wherein said claims are under final rejection. Examiner acknowledges that claim 2 has been made dependent upon claim 1; however, claim 2 is still drawn to a method of treating a substrate, nonelected in Paper #11.

Applicant's Amendments have overcome the 35 U.S.C. 112, second paragraph, rejections previously of record.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 30-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

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Dombay, U.S. Patent No. 3,554,785, teaches and exemplifies a process for treating wood (teak) with a kit as claimed in order to obtain a color on the wood, see Example 4. Specifically, the "kit" comprises a solution A which contains the metal salt cupric sulfate in the claimed amounts, as well as an acid (hydrochloric) as claimed, see Example 4. This composition is diluted with water and is first applied to the wood. The wood is then treated with a second aqueous solution which contains hydrogen peroxide in the claimed amounts, see Example 4 and col. 3, lines 19-25. Dombay teaches that this solution is also suitable for dilution as claimed, see col. 5, lines 56-64. Dombay, therefore, clearly anticipates wood treating and coloring kits as claimed.

Claims 1 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dombay. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Dombay is relied upon as set forth above as teaching and exemplifying wood coloring kits which comprise an aqueous solution of a metal salt, and an aqueous solution of hydrogen peroxide as claimed. Dombay teaches that the peroxide oxidant may be present in the lower claimed proportions (see col. 4, lines 35-38), but does not exemplify a kit which contains the peroxide in such proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a kit which comprises a first composition which contains water and a metal salt in the claimed amounts, and a second composition which contains water and hydrogen peroxide in

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the claimed amounts, wherein each composition is sequentially applied to wood to color the wood, because such kits fall within the scope of those as taught by Dombay.

Claims 1, 30 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Zemans. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Zemans, U.S. Patent No. 4,144,089, teaches a method for bleaching wood wherein the wood is first treated with a basic solution, followed by treatment with hydrogen peroxide, see claim 1. The patentee exemplifies the use of a 10% sodium carbonate (basic metal salt) solution and a 50% hydrogen peroxide solution, see col. 2, line 44-col. 3, line 8. Zemans, therefore, clearly anticipates kits which comprise solutions of metal salts and hydrogen peroxide in the claimed amounts.

Claims 1 and 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gentile. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Gentile Jr., U.S. Patent No. 4,849,053, teaches and exemplifies two and three part compositions for treating wood chips wherein one of the parts comprises an aqueous solution of metal salt (e.g. Epsom salt) in the claimed amounts, and another part comprises an aqueous solution of hydrogen peroxide in the claimed amounts, see Examples 1-6. Note that the compositions also contain additives as claimed (e.g. acids and salts). Gentile, therefore, clearly

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anticipates kits which comprise aqueous solutions of metal salts and hydrogen peroxide in the claimed amounts.

Claims 1 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Gentile is relied upon as set forth above as teaching and exemplifying compositions which contain the claimed "kits" which comprise a first aqueous composition which contains a metal salt in the claimed amounts, and a second aqueous composition which contains hydrogen peroxide in the claimed amounts. Gentile teaches that the compositions which contain the peroxide may contain from 10-100 grams/liter hydrogen peroxide, see col. 7, lines 48-55. Gentile does not exemplify the claimed lower peroxide proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate "kits" which comprise two compositions, the first of which contains water and a metal salt in the claimed amounts, and the second of which contains water and hydrogen peroxide in the claimed amounts, because such two-part "kits" or compositions are taught by Gentile.

Claims 1 and 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

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Brown, U.S. Patent No. 5,173,085, teaches and exemplifies three-part compositions for dyeing hair wherein the first part comprises an aqueous solution which contains additives (e.g. a surfactant) and a metal salt (e.g. copper sulfate) in the claimed amounts, and the third part comprises a 6% aqueous solution of hydrogen peroxide, see Examples 2-4. Brown, therefore, clearly anticipates the claimed kits which comprise aqueous metal salt and peroxide solutions.

Claims 1 and 30-35 are rejected under 35 U.S.C. 102(b) as anticipated by Hall. This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Hall, U.S. Patent No. 3,632,295, teaches and exemplifies two-part compositions for bleaching hair or wool, wherein the first part contains a metal salt (e.g. ferrous ammonium sulfate) in the claimed amounts, water, and additives (e.g. acids), and the second part contains water and a peroxide in the claimed amounts, see Examples 1-5. Hall, therefore, clearly anticipates the claimed kits which comprise aqueous metal salt and peroxide solutions.

Claims 30-31 are rejected under 35 U.S.C. 102(b) as anticipated by Est. Light Ind. Min (herein referred to as Light). This rejection is maintained primarily for the reasons as set forth into the previous Office Action, Paper#12 mailed 7/17/98.

Light, SU 499,297 (see English language translation for all citations), teaches processes for treating leather by first tanning it with a solution of hydrogen peroxide (an oxygen source) and sodium hydroxide (a salt or base), followed by treating with aluminum salts (a metal salt), see

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Example. Light, therefore, clearly anticipates kits which comprise a peroxygen source and a metal salt preparation as claimed.

Applicant's Remarks regarding the above rejections have been fully considered, but are not deemed persuasive for the following reasons:

Applicant argues that Dombay uses methylated spirits, which are particularly avoided by the claimed invention as taught in the specification. The claimed "comprising" language is open to all components, including Dombay's methylated spirits. Therefore, this argument is not deemed persuasive to overcome any rejection over Dombay.

Applicant argues that Dombay does not teach or suggest any kit as claimed which comprises a first applied aqueous mineral salt solution and second applied aqueous peroxide solution, wherein the components react in situ on the substrate. Examiner respectfully disagrees because Dombay not only teaches, but also exemplifies such kits as explained above.

Applicant argues that Zemans requires acids, which leads away from the claimed invention. Again, the instant claims do not exclude any components from the claimed kits. The claimed "comprising" language is open to all components. In fact, claim 31 recites acids as appropriate additives for the claimed kits. Applicant argues that Zemans's sodium carbonate is not the mineral salt of the claimed invention. Examiner respectfully disagrees because this mineral salt falls within the scope of those as defined by Applicant in the specification on page 5, line 25- page 6, line 7, see particularly page 6, lines 1 and 7. Applicant further argues that Zemans's release of oxygen for bleaching has nothing to do with the unique coloring of the claimed



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invention. First of all, the intended use of the claimed kits is given little patentable weight. See *In re Alberton*, 141 USPQ 730 (CCPA 1964) and *In re Heck*, 114 USPQ 161 (CCPA 1957).

Furthermore, even if the intended use of the claimed kits was patentably significant, the kits of claim 30 are defined as imparting a physical characteristic to a substrate. This would certainly read on Zemans's kits which bleach wood. Lastly, "bleaching" does impart a desired color to a substrate, i.e. a natural or bleached color.

Applicant argues that Gentile's production of wood pulp has nothing to do with the claimed substrates. This argument is not deemed persuasive because the claimed substrates are never defined or limited by the claimed kits. Applicant is reading the instant claims narrower in scope than they actually appear. No particular substrates are recited in the claimed kits, and therefore, the components within the claimed kits may be applied to any substrate. Furthermore, even if the claimed kits were limited to a particular substrate, this would be an intended use of the claimed kits, which is not given patentable weight.

Applicant argues that Gentile has nothing to do with the claimed in situ reaction of mineral salts and peroxides, and the unique coloring processes of the claimed invention. Applicant is reading process steps into the kits claims. The claimed kits merely require two components, an aqueous mineral salt solution and an aqueous peroxide solution. The intended use or processes of using these kits cannot be read into the claims.

Applicant argues that Brown is unrelated art (hair dyeing). Again, no substrates are defined by the claimed kits; therefore, Brown is not only related, but is also equivalent to the

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claimed kits which are used to treat substrates, wherein the substrates are hair. Applicant argues that Brown's processes are contrary to the claimed invention; however, no process claims were examined. The Office holds the position that Brown anticipates kits as claimed.

Applicant again argues that Hall's treatment of hair/wool with a ferrous salt and chelating agent has nothing to do with the claimed kits wherein the salt and peroxide are applied sequentially to produce an in situ reaction with the substrate. Examiner respectfully disagrees because Hall's kits include a ferrous salt which is first applied, followed by the application of a peroxide, wherein the in situ reaction between the salt and peroxide causes bleaching without decomposition of the keratin.

Applicant argues that Su '297 has nothing to do with color preservation as uniquely provided by the claimed invention. There is no "color preservation" recited in the claims, and again, the intended use of the claimed kits is not given patentable weight.

Applicant argues that none of the references teach the claimed two-step in situ treatment with kits as claimed. Applicant argues that the claimed processes enhance variations within wood, while the prior art teaches obtaining more uniform colors. Applicant argues that the use of mineral salt ions, specifically iron, zinc and silver, are not taught by the art to impart a darker color woods. Applicant argues that the lightfastness is better than conventionally used prior art dyes, and excludes the use of hazardous VOC's and other chemicals. Applicant lists several metal salts which are used in the claimed invention, and several compounds which are not used.

Applicant argues that the present processes have different application techniques that the prior art,

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that any surface preparation technique can be used, that the substrate is dry prior to application of the catalyst solution, and results in “aged” or antique looking colors. All of these arguments are directed towards specific aspects of Applicant’s invention which are *not included in the instantly claimed and examined invention*. Process steps or results cannot be read into the kits claims, and are not recited by the kits claims (e.g. wood preparation and application techniques). No specific metal salts are claimed, and no components are excluded from the claimed kits. There is no evidence of record showing better results than any prior art of record, and even if such evidence was provided, it could not be used to overcome a 102 rejection. For all these reasons, the rejections remain for the reasons of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Lieberman, can be reached on (703) 308-2523. All official before final faxes should be sent to (703)305-7718. All official after final faxes should be sent to (703)305-3599. All non-official faxes should be sent to (703)305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.  
December 22, 1998

*Caroline D. Liott*  
*Caroline D. Liott*  
*Patent Examiner*  
*TC 1700*